

REMARKS/ARGUMENTS

Claims 14-16 have been canceled. Claims 1, 3-8 and 11-13 and new Claims 17-21 are active in the case. Reconsideration is respectfully requested.

The present invention relates to a process of preparing a radiation-curable urethane (meth)acrylate.

Claim Rejection, 35 USC 112

It is believed that the amendments made to Claims 1 and 13 obviate the issue raised on non-reference grounds. Antecedent basis for the fluid medium of Claim 13 has been provided and the ratio of fully esterified alkoxylated polyol (A) to partially esterified alkoxylated polyol (A) or unesterified alkoxylated polyol (A) has been clarified. Withdrawal of the rejection of the claims is respectfully requested.

Claim Amendments

Basis for the subject matter of new Claims 17 and 18 can be found on page 19 of the specification. Basis for new Claims 19-21 can be found in cancelled Claims 14-16. No new matter been introduced into the case by the newly presented claims.

As to the matter of the rejection of the claims over the Lokai et al and Niehaus et al references, applicants maintain that their position as previously stated in the response filed October 2007 with respect to the matter of how they are combined. Applicants emphatically deny that it would have been obvious to one of skill to replace the reactive diluents disclosed in Lokai et al with the hydroxyalkyl(meth)acrylates of Niehaus et al in order to achieve a different product from that of Lokai et al which has some type of improved properties (unspecified). The fact is that if one of skill in the art were to employ the

hydroxyalkyl(meth)acrylate of Niehaus et al before reaction of the epoxide with the partial (meth)acrylate ester, the reaction medium to which the epoxide is added would contain hydroxyl groups from at least two quite different (meth)acrylate compounds, whereas, if the hydroxyalkyl(meth)acrylate of Niehaus et al is added to the reaction system of Lokai et al after the starting hydroxyl group containing (meth)acrylic acid has reacted with epoxide, the final polyisocyanate reactant has primarily only the hydroxyalkyl(meth)acrylate of Niehaus et al to react with, which would result in a product that one of skill in the art would not expect to be that of Lokai et al. Accordingly, one of skill in the art would not be so motivated to combine the two references with the expectation of arriving at a process, which would be the present process, that somehow produces a materially different product for use in coating applications which provide some type of improved characteristics. Accordingly, applicants believe that the present invention as claimed is patentable over the previously cited prior art.

It is believed that the application is in proper condition for consideration on its merits.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)



Frederick D. Vastine, Ph.D.
Registration No. 27,013

NFO:FDV